

REMARKS

The Application has been carefully reviewed in light of the Office Action dated December 17, 2004. Claims 46 to 95 are in the application, of which Claims 46, 49, 52, 57 and 59 to 68 are independent. Claims 52, 57 and 63 to 68 are being amended herein. Reconsideration and further examination are respectfully requested.

Initially, and in response to the request made in the Office Action, a copy of page 2 of the September 7, 2004 Amendment is being submitted with this paper.

The amendments made to Claims 52, 57 and 63 to 68 herein are believed to be of a minor nature, and are meant to correct some minor errors of a clerical nature. They are not being made in response to the claim rejections set forth in the Office Action, however.

By the Office Action, Claims 46, 48 to 53, 56 to 67 and 70 to 95 are rejected under 35 U.S.C. § 103(a) over WO 95/35534 (Combaluzier) and U.S. Patent No. 6,032,857 (Kitagawa), Claim 47 is rejected under 35 U.S.C. § 103(a) over Combaluzier, Kitagawa and U.S. Patent No. 5,015,830 (Masuzawa), and Claims 54, 55, 68 and 69 are rejected under 35 U.S.C. § 103(a) over Combaluzier, Kitagawa and U.S. Patent No. 6,308,202 (Cohn). Reconsideration and withdrawal of the rejections are respectfully requested.

The present invention generally concerns a card the surface of which has selectable indicia. The card further includes storage that stores memory references to an external memory device, the memory references are associated with the surface indicia, wherein selection of one of the indicia while the card is inserted in a reader causes corresponding data stored in the external memory device to be accessed using the memory reference associated with the selected indicium.

Thus, by virtue of the above arrangement, each of a number of cards can be created to be used to access external data in response to selection of an indicia of the card, which has stored on it associations between the indicia and references to the memory of the external memory device.

Turning to the specific language of the claims, Claim 46 defines a card customizing apparatus for customizing a card adapted for insertion into a card reader that communicates with a computer device. The card comprises selectable indicia on a surface of the card and a storage device storing memory references relating to an external memory device. The memory references are associated with the indicia wherein selection of one of the indicia while the card is inserted into the reader causes corresponding data stored in the external memory device to be accessed, using the memory reference associated with the selected indicium. A processor is configured to write the memory references into the storage device of said card.

The applied art, namely Combulizier and Kitagawa, is not seen to teach each and every one of the above-identified features, particularly as regards a card storing memory references associated with indicia on the surface of the card, the memory references are related to an external memory device, such that when an indicium is selected the memory reference associated with the selected indicium is used to access of corresponding data stored in the external memory device.

The Office Action, at pages 7 and 8, indicates that Combuzier is being relied on to show a card having selectable indicia on its surface, and stored memory references associated with the indicia. In addition, the Office Action cites col. 1, lines 54 to 60, col. 2, lines 21 to 30 and 42 to 52, col. 7, lines 30 to 35 and col. 8, lines 3 to 43 of

Kitagawa, and states that Kitigawa is relied on for showing a card storing memory references relating to an external memory device. The Office Action concludes that it would have been obvious, based on Kitigawa, to modify the teachings of Combaluzier to store in the memory of the card associations between indicia on the card and references to memory of an external memory device.

However, it is submitted that even if Combaluzier and Kitagawa were combined, if such a combination is even permissible, the teachings of both references would not render the present invention obvious. In addition, it is submitted that the modification of the teachings of Combaluzier as suggested by the Office Action improperly relies on hindsight based on a knowledge of the teachings of the present invention. Accordingly, the rejection of the claims based on such a combination is traversed, and withdrawal of the rejection is respectfully requested.

More particularly, Combaluzier is seen to describe a card which has indicia on its surface and a memory for storing information which attributes a function to the indicia. Kitigawa is seen to describe a card which has a memory which stores electronic transaction data as part of an electronic money system. The cited portions of Kitigawa are seen to describe saving transaction information from a point-of-sale device to the card, where the transaction information can include an address such as an Internet address or CATV address. Referring to Figure 7 and col. 10, lines 1 to 32, Kitigawa is seen to describe that an address stored in the card's memory is read when the card is inserted in the card reader connected to the user's personal computer. Communication software running on the personal computer is used to access the network address.

Thus, Kitigawa is seen merely to store a memory address in the card's memory as part of a sale, or other money transaction, and to read the transaction information, including the memory reference, when the card is inserted in the card reader. Like Combaluzier, Kitigawa is not seen to in any way associate a memory reference relating to an external memory device to indicia on the surface of the card. It follows then that Kitigawa cannot be seen to show using a memory reference associated with a card's surface indicium to access data stored in an external memory device when the indicium is selected.

In addition, the combination suggested in the Office Action would require that the card described in Combaluzier be modified to receive transaction information, including a network address, from an electronic money system, whereby the transaction information stored on the card is to be read by a PC which accesses the network address using its communication software. In addition, it would be necessary to further modify the teachings of Combaluzier to associate the transaction information to indicium of the card. It is submitted that nothing in Combaluzier, or in Kitigawa, suggests these modification.


Accordingly, it is believed that the claims herein recite subject matter that would not have been obvious over any permissible combination of the cited references.

In this regard, the remaining art, namely Cohn and Masuzawa, as been reviewed and is not seen to render the obvious the subject matter of the claims.

In view of the foregoing, the entire application is believed to be in condition for allowancc, and such action is respectfully requested at the Examiner's earliest convenience.

Applicants' undersigned attorney may be reached in our Costa Mesa, California office by telephone at (714) 540-8700. All correspondence should be directed to our address given below.

Respectfully submitted,



Carole A. Quinn  
Attorney for Applicants  
Registration No.: 39,000

FITZPATRICK, CELLA, HARPER & SCINTO  
30 Rockefeller Plaza  
New York, New York 10112-2200  
Facsimile: (212) 218-2200

CA\_MAIN 52948v1